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In re Application of SHUSTER et al :
U.S. Application No.: 10/571,041 :
PCT Application No.: PCT/US2004/028888 : DECISION
Int. Filing Date: 07 September 2004 :
Priority Date Claimed: 05 September 2003 :
Attorney Docket No.: 25791.305.05 :
For: EXPANDABLE TUBULAR :

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 28 August 2007.

BACKGROUND

On 07 September 2004, applicant filed international application PCT/US2004/028888, which claimed priority of an earlier United States application filed 05 September 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 March 2006 (05 March 2006 was a Sunday).

On 03 March 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a substitute specification.

On 26 October 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a properly executed oath or declaration must be filed.

On 01 November 2006, applicant filed a purported declaration.

On 31 May 2007, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 28 August 2007, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of international application PCT/US2004/028888 reveals that the application contained 1369 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492**>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

In the present case, the initial national stage submission on 03 March 2006 did not include a proper preliminary amendment. However, it is apparent from the papers filed 03 March 2006 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 42 claims, rather than the 1369 claims contained in the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 42 claims as opposed to 1369 claims. A proper preliminary amendment was filed with the present petition, reducing the total number of claims to 42. Because of applicant's intent to reduce the number of claims for examination and because the fees due for the presence of 1369 claims at the time of the initial national stage submission would not be remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

A review of the purported declaration filed 01 November 2006 reveals that it is not in compliance with 37 CFR 1.497 (a)(2)¹ and (a)(4).² Accordingly, the Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 31 May 2007 is hereby VACATED.

The application is being forwarded to the DO/EO/US for processing in accordance with this decision, including preparation and mailing of a Notification of Defective Response (Form

¹ The first page of the declaration appears to be missing.

² Applicant is advised that the oath or declaration must properly identify the application to which it is directed. See MPEP 602, Section VI. Identification of Application.

PCT/DO/EO/916), which should indicate that the declaration filed 01 November 2006 is not in compliance with 37 CFR 1.497 (a)(2) and (a)(4).

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